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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/918,984	07/31/2001	Vivek R. Pradhan	CN 37,318-01	3817

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BP America Inc.  
Docket Clerk, Law Department, M.C. 2207A  
200 East Randolph Drive  
Chicago, IL 60601-7125

EXAMINER

ARNOLD JR., JAMES

ART UNIT	PAPER NUMBER
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1764

DATE MAILED: 11/06/2002

4

Please find below and/or attached an Office communication concerning this application or proceeding.

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**Office Action Summary**

Applicant N .

09/918,984

Applicant(s)

PRADHAN ET AL.

Examiner

James Arnold, Jr.

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-- The MAILING DATE of this communication appears on the cover sheet with the corresponding address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 31 July 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-25 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-25 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### *Claim Rejections - 35 USC § 112*

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 17 recites the limitation "the one low boiling point" in line 1 of the claim. There is insufficient antecedent basis for this limitation in this claim.

Claim 18 recites the limitation "the high boiling fraction" in line 1 of the claim. There is insufficient antecedent basis for this limitation in the claim.

In claims 17-18, it appears that the applicant wishes the claims to depend from claim 11 rather than claim 8.

### *Double Patenting*

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-25 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-25 of copending

Application No. 09/918930. Although the conflicting claims are not identical, they are not patentably distinct from each other because Both sets of claims disclose a process for the production of products which are liquid at ambient conditions and contain organic sulfur compounds of higher molecular weight than corresponding sulfur-containing compounds in the feedstock, which process comprises providing a feedstock comprising a mixture of hydrocarbons which includes olefins and sulfur-containing organic compounds, the feedstock consisting essentially of material boiling between about 60 C and about 345 C. and having a sulfur content up to about 5,000 parts per million. Both sets of claims have an initial contacting stage of elevated temperatures, contacting the feedstock with an acidic catalyst under conditions which are effective to convert a portion of the impurities to a sulfur-containing material of higher molecular weight through alkylation by the olefins, thereby forming an initial product stream; and in a subsequent contacting stage and at temperatures at least 10 C lower than an average of the elevated temperatures in the initial contacting stage, contacting at least a portion of the initial product stream with an acidic catalyst under conditions which are effective to convert a portion of the impurities to a sulfur-containing material of higher molecular weight through alkylation by the olefins, thereby forming a subsequent product stream. Both sets of claims also disclose the fractionation of the subsequent product stream by distillation to provide at least one low-boiling fraction consisting of a sulfur-lean fraction having a sulfur-content less than about 50 parts per million, and a high-boiling fraction consisting of a sulfur-rich, fraction containing the balance of the sulfur. Both sets of claims also disclose treating the high-boiling fraction with a gaseous source of dihydrogen at hydrogenation conditions in the presence of a hydrogenation catalyst which exhibits a capability to enhance the incorporation of hydrogen into one or more of

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the sulfur-containing organic compounds and under conditions suitable for hydrogenation of one or more of the sulfur-containing organic compounds; and recovering a high-boiling liquid having a sulfur content less than about 50 parts per million.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to utilize the step of removing nitrogen-containing impurities because nitrogen can easily be removed with an acidic catalyst

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

#### *Claim Rejections - 35 USC § 102*

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claim 25 is rejected under 35 U.S.C. 102(b) as being clearly anticipated by Kaneko (USPN 5,401,280).

The Kaneko reference discloses a composition with sulfur content less than 50 parts per million. See Column 3, lines 16-21.

#### *Claim Rejections - 35 USC § 103*

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The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 1-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Alexander (1) (USPN 6,024, 865) in view of Alexander (2) (6,059, 962).

Alexander (1) discloses a product that contains organic sulfur compounds of higher molecular weight than corresponding sulfur-containing compounds in the feedstock. See Abstract and Column 1, lines 21-24. The reference also discloses a feedstock comprising a mixture of hydrocarbons which includes olefins, and sulfur-containing organic compounds and nitrogen-containing organic compounds. See Column 1, lines 28-41 and figure 2. The reference also discloses a feedstock consisting essentially of material boiling between about 60 C and 345 C and containing sulfur. Column 7, lines 48-52. Furthermore, the reference discloses passing the feedstock through a bed of solid adsorbent to remove nitrogen and obtain an effluent which contains less of nitrogen-containing organic compounds than the feedstock. Column 14, lines 29-56. The reference furthermore discloses a first contacting stage in which the effluent is

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contacted with an acidic catalyst under conditions which are effective to convert a portion of the impurities to a sulfur-containing material of higher molecular weight through alkylation by the olefins, thereby forming an initial product stream. See Column 24, lines 1-5. The reference also discloses a subsequent contacting stage contacting at least a portion of the initial product stream with an acidic catalyst under conditions which are effective to convert a portion of the impurities to sulfur-containing material of higher molecular weight through alkylation by the olefins, thereby forming a subsequent product stream. See column 24, lines 12-20. The reference discloses a petroleum feedstock comprised of naphtha from a catalytic cracking process. Column 1, lines 26-41. The reference also discloses the use of a solid phosphoric acid catalyst in at least one of the contacting stages. Column 21, lines 30-32 and Column 24, lines 1-5. The reference also discloses a process wherein the acidic catalyst of the subsequent contacting stage is comprised of a material which is prepared from an acidic catalyst by use in the first contacting stage, and the solid adsorbent is comprised of material which is prepared from the acidic catalyst by use in the first contacting stage and/or the second contacting stage. Column 13, lines 14-30. The reference also discloses a process whereby the feedstock is comprised of a hydrating agent in an amount which exhibits a capability to enhance performance of the catalyst and consisting of a hydrating agent having from about 2 to about 5 carbon atoms. Column 13, lines 14-34. The reference also discloses fractionating the subsequent product stream by distillation to provide at least one low-boiling fraction consisting of a sulfur-lean fraction and a high boiling fraction containing a sulfur-rich fraction. See Column 24, lines 58-63 and Column 26, lines 20-22. The reference also discloses a distillation endpoint and an initial boiling temperature in the range of from about 150 C to about 190 C. Column 24, lines 26-29. The reference also discloses a

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process whereby the high-boiling fraction has a distillation end point below 249 C. See Column 24, lines 30-31.

The Alexander (1) reference does not disclose a sulfur content up to about 4,000 or 5,000 parts per million and a nitrogen content up to about 2,000 parts per million. The reference also does not disclose a first contacting stage at elevated temperatures nor a second contacting stage at temperatures at least 10 C lower than an average of the elevated temperatures in the first connecting stage. The reference also does not disclose a naphtha from a thermal cracking process. The reference also does not disclose a process wherein the olefin content is at least equal on a molar basis to that of the sulfur-containing organic compounds. The reference also does not disclose a process wherein the elevated temperatures used in the initial contacting stage are in a range of from about 100 C to about 235 C. Furthermore, the reference does not disclose a process wherein the temperatures in the subsequent contacting stage are at least 15 C lower than an average of the elevated temperatures in the initial contacting stage. The reference also does not disclose a fractionation resulting in a sulfur content less than 50 ppm. The reference does not disclose elevated temperatures for the initial contacting stage in the range from about 110 C to 220 C whereby the temperatures used in the subsequent contacting stage is at least 30 C lower than an average of the elevated temperatures in the initial contacting stage. The reference also does not disclose a process whereby one low-boiling fraction has a distillation end point and the high-boiling fraction has an initial boiling point such that the distillation end point and the initial boiling point are in the range from about 80 C to about 220 C. Furthermore, the reference does not disclose treating the high boiling fraction with a gaseous source of dihydrogen at hydrogenation conditions and in the presence of a hydrogenation catalyst. The reference does



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not disclose a process whereby the hydrogenation catalyst comprises at least one active metal, selected from the group consisting of the d-transition elements, each incorporated onto an inert support in an amount of from about 0.1 percent to about 20 percent by weight of the total catalyst. The reference does not disclose a process whereby the hydrogenation catalyst comes from the group consisting of cobalt, nickel, molybdenum, and tungsten. Finally, the reference does not disclose a process whereby the treatment of the high-boiling fraction with a gaseous source of dihydrogen employs at least one bed of hydrogenation catalyst comprising nickel and one or more metals selected from the group consisting of, molybdenum and tungsten, each incorporated onto an inert support in an amount of from about 0.1 percent to about 20 percent by weight of the total catalyst.

The Alexander (2) (USPN 6,059,962) discloses a process whereby the olefin content of the feedstock is at least equal on a molar basis to that of the sulfur-containing organic compounds. Column 23, lines 59-61.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the process of Alexander (1) to utilize a feedstock whereby the olefin content is at least equal to that of the sulfur-containing organic compound because both Alexander (1) and Alexander (2) disclose a process for sulfur removal and this removal would be made easier by utilizing a feedstock with a lower concentration of sulfur relative to olefin content. It would have been obvious to one having ordinary skill in the art at the time the invention was made to utilize a sulfur content up to about 4,000 or 5,000 parts per million and a nitrogen content up to about 2,000 parts per million because the Alexander (1) reference generally provides for a wide range of acceptable feedstocks. See Column 1, lines 17-41. It

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would have been obvious to one having ordinary skill in the art at the time the invention was made to utilize a first contacting stage at elevated temperatures and a second contacting stage at temperatures at least 10 C lower than an average of the elevated temperatures in the first connecting stage because the Alexander(1) reference discloses utilization of these stages under effective conditions. It would have been obvious to one having ordinary skill in the art at the time the invention was made to utilize a naphtha from a thermal cracking process because the Alexander (1) reference generally provides for a wide range of acceptable feedstocks. See Column 1, lines 17-41. It would have been obvious to one having ordinary skill in the art at the time the invention was made to utilize a process wherein the elevated temperatures used in the initial contacting stage are in a range of from about 100 C to about 235 C because the Alexander (1) reference discloses utilization of stages under effective conditions. It would have been obvious to one having ordinary skill in the art at the time the invention was made to utilize a process wherein the temperatures in the subsequent contacting stage are at least 15 C lower than an average of the elevated temperatures in the initial contacting stage because the Alexander (1) reference discloses utilization of stages under effective conditions. It would have been obvious to one having ordinary skill in the art at the time the invention was made to utilize a fractionation resulting in a sulfur content less than 50 ppm because the Alexander (1) and Alexander (2) references disclose the process of sulfur removal and it would be appropriate to utilize the process in any way which would result in effective sulfur removal. It would have been obvious to one having ordinary skill in the art at the time the invention was made to utilize elevated temperatures for the initial contacting stage in the range from about 110 C to 220 C whereby the temperatures used in the subsequent contacting stage is at least 30 C lower than an average of the

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elevated temperatures in the initial contacting stage because the Alexander(1) reference discloses utilization of these stages under effective conditions. It would have been obvious to one having ordinary skill in the art at the time the invention was made to utilize a process whereby one low-boiling fraction has a distillation end point and the high-boiling fraction has an initial boiling point such that the distillation end point and the initial boiling point are in the range from about 80 C to about 220 C because the Alexander (1) reference discloses distillation end point and initial boiling point range of about 150 C to about 190 C and therefore any range which would be effective for sulfur reduction may be utilized. Finally, it would have been obvious to one having ordinary skill in the art at the time the invention was made to treat the high boiling fraction with a gaseous source of dihydrogen at hydrogenation conditions and in the presence of a hydrogenation catalyst; utilize a process whereby the hydrogenation catalyst comprises at least one active metal, selected from the group consisting of the d-transition elements, each incorporated onto an inert support in an amount of from about 0.1 percent to about 20 percent by weight of the total catalyst; utilize a process whereby the hydrogenation catalyst comes from the group consisting of cobalt, nickel, molybdenum, and tungsten; and utilize a process whereby the treatment of the high-boiling fraction with a gaseous source of dihydrogen employs at least one bed of hydrogenation catalyst comprising nickel and one or more metals selected from the group consisting of, molybdenum and tungsten, each incorporated onto an inert support in an amount of from about 0.1 percent to about 20 percent by weight of the total catalyst because the Alexander (1) reference discloses the obtainment of low sulfur products through hydrotreatment in the presence of a catalyst.

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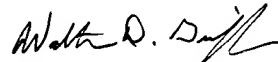
***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to James Arnold, Jr. whose telephone number is 703-305-5308. The examiner can normally be reached on Monday-Thursday 8:30 AM-6:00 PM; Fridays from 8:30 AM-5:00 PM with alternate Fridays off..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Marian Knode can be reached on 703-308-4311. The fax phone numbers for the organization where this application or proceeding is assigned are 703-305-3014 for regular communications and 703-305-3014 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0196.

ja  
November 1, 2002

  
**Walter D. Griffin**  
**Primary Examiner**